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REMARKS

Claims 1-10 and 12-22 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-22 Under 35 U.S.C. §103(a)

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li *et al.*, U.S. Patent Number 5,672,858, in view of Clark, *et al.*, U.S. Patent Number RE37,635. It is respectfully requested that this rejection be withdrawn for at least the following reason. Li *et al.* and Clark *et al.*, either alone or in combination, fail to teach or suggest all the limitations set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The invention as claimed relates to an image collecting module operable to read one-dimensional, two-dimensional and hybrid dataforms. The image collecting module comprises an indicator system and a method that provides a user with indication of either a valid read or an invalid read of a hybrid dataform. In particular, independent claim 1 recites *a first multicolor photo indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform*. In addition, independent claims 13 and 20, and associated dependent claims, respectively recite a method and a means for effectuating the invention as claimed. It is apparent therefore that the claimed invention

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utilizes *a multicolored* photo indicator to apprise the user of the validity, or lack thereof, of the reading of hybrid dataforms by the image collecting module. *Li et al.* and *Clark et al.* fail to teach or suggest this novel aspect of the claimed invention.

As the Examiner acknowledges, in the instant Final Office Action dated August 9, 2004, *Li et al.* fails to provide the user an indication that a hybrid dataform has been successfully read through the use of *a multicolored* photo indicator. In recognition of the deficiency presented by *Li et al.* the Examiner attempts to utilize *Clark et al.*, and directs applicant's representative to col. 3, line 65-col. 4, line 4, which states:

... in the scanner illustrated in the Eastman, *et al.* patent, illuminates *an LED or light emitting diode*, which indicates to the operator that a bar code symbol has been successfully decoded. The carrier detect line to pin 1 of the COMPORT carries the command indicating that the laser scanner's trigger has been pulled. The signal representing the command results from a switch closure as explained in the Eastman, *et al.* patent. (emphasis added).

As was stated by the applicant's representative in the Reply to Office Action dated January 15, 2004, and is reiterated herein, *Clark et al.* discloses a *monochromatic* LED that indicates to the operator that a bar code symbol has been successfully decoded. *Clark et al.*, unlike the invention as claimed, fails to disclose *a multicolor photo indicator* to apprise the operator of a successful read of the dataform. The Examiner nevertheless contends, in the Response to Arguments section of the instant Final Office Action dated August 9, 2004, that "[t]he LED is capable of being a multicolor indicator, wherein the LED could display a different color indicating the result of the read operation [and provides] as evidence ... a new cited reference Leister (US 5,196,686, col. 2, lines 37-52)". *Id.* at page 3. Applicant's representative disagrees. Leister in the cited passage illustrates the utilization of "*a pair of indicator lights 44 and 46 indicating whether the scan operation resulted in a good read (green) or a bad read (red).*" col. 2, lines 43-45 (emphasis added). Leister therefore does not teach or suggest the *multicolor photo indicator* as recited in the subject claims, but rather two distinct lights to indicate whether a good or bad read has taken place. Thus, it is submitted that Leister consequentially fails to provide the evidentiary support for which the Examiner cites the document.

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With respect to independent claims 21 and 22, the Examiner rejects these claims out of hand by claiming in the Final Office Action dated August 9, 2004, that "using sound/vibration indicating means, they are functionally equivalent as the LEDS means. Therefore, it would have been an obvious extension as taught by Li *et al.*" See, page 3. Applicant's representative avers to the contrary, and contends that the Examiner is conflating the differences between human sensory perceptions, i.e., sight, sound, taste, touch and smell, in order to substantiate an argument in sophism, and is further attempting to utilize applicant's specification as a 20/20 hindsight-based roadmap to achieve the purported combination. As the Examiner must surely admit, an auditory signal cannot be equated to either a visual signal or a tactile signal, as each signal is directed toward a different and distinct human sensory perception, viz., an auditory signal is addressed by the human perception of sound, a visual signal is perceived by the sense of sight, and a tactile signal is perceived by the sense of touch. Thus, it is submitted that these perceptions, although effectuated through physical manifestations, cannot be addressed in an equivalent manner because each physical manifestation is directed toward a particular and distinct attribute of the human sensory system.

In addition, and by the Examiner's own admission, Li *et al.* fails to "disclose or fairly suggest that the indication means of the reader are LEDs (i.e. photo, illumination, lights) or vibration signal for indicating a valid read." See Final Office Action dated August 9, 2004, pages 2-3. Thus, applicant's representative is unable to comprehend how the use of sound/vibration indicating means can be functionally equivalent to a LED means, when the means to which the Examiner directs the applicant's representative, i.e. LEDs, is by the Examiner's own concession, not present in the cited document. It is therefore submitted that since Li *et al.* fails to teach or suggest a LED means, that the Examiner is attempting to utilize an impermissible 20/20 hindsight-based roadmap to achieve the purported combination.

In view of at least the foregoing and since neither Li *et al.* nor Clark *et al.*, either alone or in combination, contemplate the invention in its totality as set forth in the subject claims, it is respectfully requested that this rejection be withdrawn with respect to independent claims 1, 13, 20, 21 and 22, and associated dependent claims.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731